No. 17-1594

IN THE

Supreme Court of the United States

RETURN MAIL, INC.,

Petitioner,

v.

UNITED STATES POSTAL SERVICE, ET AL.,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF NEITHER PARTY

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QUESTION PRESENTED

Whether the government is a "person" who may petition to institute review proceedings under the AIA?

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INTEREST OF AMICUS CURIAE

The New York Intellectual Property Law Association ("NYIPLA" or "Association") respectfully submits this *amicus curiae* brief in support of neither party.[1] The arguments set forth herein were approved on December 11, 2018 by an absolute majority of the officers and members of the Board of Directors of the NYIPLA, including any officers or directors who did not vote for any reason, including recusal, but do not necessarily reflect the views of a majority of the members of the Association, or of the law or corporate firms with which those members are associated. After reasonable investigation, the NYIPLA believes that no officer or director or member of the Committee on Amicus Briefs who voted in favor of filing this brief, nor any attorney associated with any such officer, director or committee member in any law or corporate firm, represents a party in this litigation.

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[1]Consent of all parties has been provided for the NYIPLA to file this brief. Petitioner and Respondents have provided consents to the filing of this *amicus curiae* brief in support of neither party in communications dated December 7, 2018 and December 12, 2018, respectively. Pursuant to Sup. Ct. R. 37.6, no counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than the NYIPLA, its members, or its counsel made a monetary contribution to its preparation or submission.

The NYIPLA is a bar association of more than 1,000 attorneys who practice in the area of patent, copyright, trademark, and other intellectual property ("IP") law. It is one of the largest regional IP bar associations in the United States. The Association's members include a diverse array of attorneys specializing in patent law, from in-house counsel for businesses that own, enforce and challenge patents, to attorneys in private practice who represent inventors and petitioners in various proceedings before the United States Patent and Trademark Office ("PTO").

A substantial percentage of the Association's member attorneys participate actively in patent litigation, representing both patent owners and accused infringers. In addition, many of the NYIPLA's member attorneys are involved in *inter partes* review ("IPR") and other post-issuance proceedings, on both sides of patent validity issues.

The NYIPLA thus brings an informed perspective to the issues presented. The NYIPLA, its members, and their respective clients share a strong interest in the issues presented by this case. It is critical that the standards as to who can participate in Patent Trial and Appeal Board ("PTAB") proceedings, specifically IPR, post grant review ("PGR") and covered business method review ("CBM") proceedings are clarified to ensure a smooth, predictable process for all stakeholders.

SUMMARY OF ARGUMENTS

I. While the general rule is that "person" should be interpreted to exclude a sovereign, that rule is flexible and must be adjusted to the circumstances of the particular statute. *United States v. Cooper Corp.*, 312 U.S. 600, 604-05 (1941). In the context of Title 35 of the U.S. Code ("Patent Act"), the use of the term "person" is inconsistent and consequently the term must be defined in the context of the particular section in which it is used. Specifically, in some instances, "person" means a human being (and not even an entity), such as who can be the PTO Director or a PTAB Administrative Patent Judge. *See* 35 U.S.C. §§ 3(a) and 6(a). In other instances, it expressly includes governmental entities. *See* 35 U.S.C. § 296(a). In still different instances, if "person" excluded government entities, it would lead to absurd results. *See* 35 U.S.C. § 102. Thus, reliance upon the general definitions included in 1 U.S.C. § 1 (and § 8) to 35 U.S.C. *in toto*, or to the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA") specifically, is inappropriate in light of how the definition of "person," vis-a-vis governmental entities, functions within the context of the Patent Act. Likewise, resort to other statutes (*e.g.*, the Sherman Act and the Clayton Act as discussed in *Cooper*) to interpret "person" as used in the Patent Act or AIA will not be meaningful.

II. When the particular AIA statute is considered as to who may bring an IPR, PGR, or

CBM, the enabling provisions for IPRs and PGRs have the same language, whereas different and more limiting language is used for CBMs. This allows for the possibility that "person" could be construed to have different meanings for CBMs in contrast to IPRs and PGRs. Thus, the NYIPLA respectfully urges that, despite the broad wording of the question presented, the holding in this case be expressly limited to CBMs (leaving the question for IPRs and PGRs open for decision on another day in a factually more appropriate vehicle) and specifically articulate that the Court is limiting its decision to construing "person" for purposes of Section 18 of the AIA.

III. Notably, the Court has arguably construed the AIA as including "any person" (*see, e.g., Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1371 (2018)) in recognizing that these standing requirements came out of the prior *inter partes* reexamination statute and the *ex parte* reexamination statute. Prior to Congress' enactment of the AIA, the PTO's practice, as reflected in the Manual of Patent Examining Procedure ("MPEP"), was that "persons" who could bring *ex parte* and *inter partes* reexaminations included governmental entities. Indeed, Respondent U.S. Postal Service ("USPS") previously had been allowed to bring such a proceeding on this very patent, prior to enactment of the AIA and the filing of the CBM at issue in this case.

IV. The internal inconsistency of the use of "person" throughout the Patent Act, this Court's

interpretation of the AIA, and pre-existing PTO practices with respect to which "persons" could bring reexaminations prior to the AIA are all factors that this Court should consider in determining "whether the government is a 'person' who may petition to institute review proceedings with respect to the applicable provisions of the AIA." Although the NYIPLA takes no position on the merits of this dispute, it respectfully submits that the Court should construe the meaning of "person" in the AIA based on the context of each specific provision in which it is used, and consonant with the noted internal inconsistency within the Patent Act, and avoid any broad pronouncement on the meaning of "person" as generally used in the Patent Act, or otherwise. Accordingly, the NYIPLA respectfully suggests that the Court limit its holding to Section 18(a) of the AIA regarding CBM proceedings, and avoid addressing the broader question of what "person" means outside that context.

BACKGROUND

In 2011, Congress enacted the Leahy-Smith America Invents Act ("AIA"), which created three new types of post-issuance review proceedings to be conducted before the Patent Trial and Appeal Board ("PTAB"):

- *inter partes* review ("IPR");
- post-grant review ("PGR"); and
- covered business method patent review ("CBM").

The AIA provides that subject to certain conditions, a "person" may file a petition to institute such a post-issuance review proceeding:

- **For IPRs**: 35 U.S.C. § 311(a) ("Subject to the provisions of this chapter, a **person *who is not the owner of a patent*** may file with the Office a petition to institute an inter partes review of the patent.");[2]
- **For PGRs**: 35 U.S.C. § 321(a) ("Subject to the provisions of this chapter, a **person *who is not the owner of a patent*** may file with the Office a petition to institute a post-grant review of the patent."); and

[2]All emphasis added unless otherwise indicated.

- **For CBMs**: AIA § 18(a)(1)(B) ("A **person** may not file a petition for a transitional proceeding with respect to a covered business method patent unless the person or the person's real party in interest or privy has been ***sued for infringement*** of the patent or has been ***charged with infringement under that patent***.").

As this Court recognized in *Oil States*, "[t]he America Invents Act replaced *inter partes* reexamination with *inter partes* review,"[3] for which "[a]ny person other than the patent owner can file a petition." *Oil States*, 138 S. Ct. at 1371:

- **For *Ex Parte* Reexamination**: 35 U.S.C. § 302 ("**Any person at any time may file a request for [ex parte] reexamination** by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301.");

- **For Prior *Inter Partes* Reexamination**: 35 U.S.C. § 311(a) (2006 ed.) ("**Any third party requester at any time may file a request for inter partes reexamination** by the Office of a patent on the basis of any prior art cited under the provisions of section 301."); and 35 U.S.C. § 100(e) (2006 ed.) ("The term '**third-party requester**' means a **person requesting** ex parte reexamination under section 302 or **inter**

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[3]The AIA also included PGRs as part of the replacement for the prior inter partes reexamination and CBMs as a temporary additional procedure. *Oil States* did not address PGRs and CBMs in this context.

> **partes reexamination under section 311 who is not the patent owner.**").

Similarly, the Supreme Court made clear in its interpretation of Section 311(a) that "[a]ny person other than the patent owner can file a petition for inter partes review." *Oil States*, 138 S. Ct. at 1371 (citing 35 U.S.C. § 311(a) (2012 ed.)); *see also Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2137 (2016) ("Like *inter partes* reexamination, any third party can ask the agency to initiate inter partes review of a patent claim.").

Significantly, like the prior statute for *inter partes* reexamination (35 U.S.C. § 311(a) (2006 ed.)) and the existing statute for *ex parte* reexamination (35 U.S.C. § 302), neither the AIA nor any other provisions of Patent Act define the term "person." *Cf.* 35 U.S.C. § 100 (including other definitions for the Patent Act).[4]

Nonetheless, as discussed below, the practice of the PTO at the time of enactment of the AIA recognized that governmental entities were included

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[4]Section 1 of Title 1 of the U.S. Code defines "person" as including "corporations, companies, associations, firms, partnerships, societies, and joint stock companies, as well as individuals" for purposes of "determining the meaning of any Act of Congress, ***unless the context indicates otherwise***." As discussed below, this definition does not universally make sense in the context of the various provisions of the Patent Act that use the term "person," and thus is not particularly helpful.

in the "any person" that could bring an *ex parte* or *inter partes* reexamination. *See* 35 U.S.C. § 302 and MPEP § 2212 (*ex parte* reexamination); and 35 U.S.C. §§ 100(e), 311(a) and MPEP §§ 2203, 2612 (*inter partes* reexamination) (all pre-AIA). Indeed, the USPS had previously been allowed to bring an *ex parte* reexamination on the same patent that is at issue in *Return Mail, Inc. v. United States Postal Service*. *See* Case No. 90/008,470.

At issue here before the PTAB and the Federal Circuit in *Return Mail, Inc. v. United States Postal Service* was whether the USPS, admittedly a "government entity" as recognized by this Court in *United States Postal Serv. v. Flamingo Indus. (USA) Ltd.*, 540 U.S. 736, 748 (2004), has standing to petition for CBM under the AIA.

Under AIA § 18(a)(1)(B):

> A person may not file a petition for a transitional proceeding with respect to a covered business method patent **unless the person** or the person's real party in interest or privy **has been sued for infringement of the patent** or has been charged with infringement under that patent.[5]

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[5]CBM proceedings are considered a type of PGR that is in effect for a limited time period. Unlike IPRs and PGRs, the governing statutory provisions for CBMs are only

Before the USPS filed a petition for a CBM of Return Mail's patent, Return Mail had brought a suit against the United States in the U.S. Court of Federal Claims for unlicensed use of its patent. *See generally* Complaint, *Return Mail, Inc. (RMI) v. United States*, (No. 11-cv-00130) (Fed. Cl. Feb. 28, 2011). Return Mail argued that since its suit against the United States was brought under an eminent domain statute, 28 U.S.C. § 1498(a), rather than under 35 U.S.C. §§ 271 and 281 for infringement of the patent, the USPS was not "sued for infringement of the patent" or "charged with infringement" and thus lacked proper standing to petition for a CBM under the AIA.

28 U.S.C. § 1498(a) recites in part:

> Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by **action against the United States in the United States Court of Federal Claims for the recovery of his reasonable and entire compensation for such use and manufacture**.

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contained in Section 18 of the AIA and are not otherwise codified into Title 35 of the U.S. Code.

In the proceedings below, the PTAB rejected Return Mail's argument both in its institution and final written decisions and held that the USPS was "sued for infringement" within the meaning of AIA § 18(a)(1)(B) and thus had standing to petition for a CBM. *See United States Postal Service v. Return Mail, Inc.*, CBM 2014-00116, Paper 41, Final Written Decision at 12 (PTAB Oct. 15, 2015); *see also id.*, Paper 11, Institution Decision at 15-18 (PTAB Oct. 16, 2014).

The majority of the Federal Circuit panel affirmed the PTAB's holding on CBM standing. *Return Mail, Inc. v. United States Postal Service*, 868 F.3d 1350, 1366 (Fed. Cir. 2017). However, Judge Newman vigorously dissented from the majority opinion.

Judge Newman relied on a point of statutory interpretation that neither party had previously raised or discussed:

> An important threshold issue before the court is whether the United States and its agency the United States Postal Service are **within the definition of "person" in § 18(a)(1)(B) of the America Invents Act**, and thus entitled to proceed under that Act.

Id. at 1371 (Newman, J., dissenting). While the majority pointed out that "the failure to brief an issue ordinarily constitutes waiver under our

precedent," *id.* at 1365 n.15 (Prost, C.J., Majority Opinion), Judge Newman maintained that "statutory jurisdiction is not subject to waiver" since "considerations of subject matter jurisdiction are foundational to the tribunal's power." *Id.* at 1371 (Newman, J., dissenting). Judge Newman then concluded that "it is clear that the government is not included as a 'person' subject to the AIA." *Id.* at 1374. In reaching this conclusion, she also focused on the AIA's estoppel provisions:

> It is well settled that no action of the parties can confer subject-matter jurisdiction on a tribunal and that the principles of estoppel do not apply to vest subject-matter jurisdiction where Congress has not done so. The issue of whether the PTAB possesses the power to adjudicate a claim of invalidity involves subject matter jurisdiction, for the dispute must be within the limited scope granted by the Congress to the PTAB. . . .
>
> ***
>
> The Congress cannot be deemed innocent of knowing that the government can indeed be sued for infringement, but only in the Court of Federal Claims; yet that court is conspicuously absent from the

> designation of tribunals subject to the America Invents Act.

Id. at 1371-72 (internal quotation marks and citations omitted).

For example, the AIA includes the following estoppel provision with respect to petitioners for CBM proceedings:

> The petitioner in a transitional proceeding that results in a final written decision under Section 328(a) of title 35, United States Code, with respect to a claim in a covered business method patent, or the petitioner's real party in interest, may not assert, **either in a civil action arising in whole or in part under section 1338 of title 28, United States Code, or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 (19 U.S.C. 1337)**, that the claim is invalid on any ground that the petitioner raised during that transitional proceeding.

AIA § 18(a)(1)(D). In view of the failure of the AIA's estoppel provisions to include an action before the U.S. Court of Federal Claims under 28 U.S.C. § 1498(a), Judge Newman reasoned, the majority's holding that the USPS had standing to petition for a CBM under the AIA is incorrect:

> Indeed, inclusion of the government as a "person", assumed by the majority, requires the assumption that legislators intended to grant the government access to post-grant proceedings in the PTAB while also intending to remove the government from the estoppel provision, thereby giving the government "two bites at the apple," in the majority's words. Such an irregular assumption, with no hint of support in the statute or legislative history, cannot be countenanced.

Return Mail, 868 F.3d at 1375 (Newman, J., dissenting); *but see id.* at 1364 (Prost, C.J., Majority Opinion) ("Yet construing § 18(a)(1)(B) to allow the government to petition for CBM, as we do today, means that the government would enjoy the unique advantage of not being estopped in the Claims Court from re-litigating grounds raised during a CBM review proceeding. The Postal Service does not dispute the oddity of this result and acknowledges that the government would not be subject to estoppel under this construction. Although this raises certain policy concerns, **Congress is better suited to address them by revising the estoppel provisions for CBM review should it see fit.**").[6]

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[6]The NYIPLA notes that, irrespective of whether a statutory estoppel were to be applied to such proceedings, other forms of estoppel may still be available against the

ARGUMENT

As this Court has become quite familiar, with the enactment of the AIA, Congress created a series of new post-issuance proceedings including IPR, PGR and CBM proceedings, where any petitioner may request the Government to take "a second look at an earlier administrative grant of a patent." *Cuozzo*, 136 S. Ct. at 2144. Further, as this Court has recognized with respect to IPR proceedings, "[a]ny person other than the patent owner can file a petition for inter partes review." *Oil States*, 138 S. Ct. at 1371 (citing 35 U.S.C. § 311(a) (2012 ed.)). In this matter, this Court has elected to decide whether any "person" includes Petitioner USPS, a governmental entity, in the context of a CBM proceeding under AIA § 18(a)(1)(B). Although the Court has accepted a

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government for any positions it argues in post-issuance review proceedings under the AIA that result in a final written decision. *Cf. MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1376 (Fed. Cir. 2018) ("It is well established that collateral estoppel, also known as issue preclusion, applies in the administrative context." (citing *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1303 (2015))). In addition, the PTAB has applied such principles between *inter partes* review proceedings. *See, e.g., Google LLC v. Makor Issues & Rights Ltd.*, IPR2017-00818, Paper 25 at 44 n.7 (PTAB Sept. 7, 2018) ("Patent Owner is therefore collaterally estopped from challenging our prior determination related to the traffic jam limitation – as admitted by Patent Owner's counsel during oral hearing." (citations omitted)).

question that is more broadly worded, the NYIPLA encourages the Court to limit its holding to the context of CBM proceedings, which may or may not provide the meaning of "person" as set forth in 35 U.S.C. § 311(a) for IPRs and 35 U.S.C. § 321(a) for PGRs.

Section I hereto explains that there can be no global definition of "person" in the Patent Act or the AIA. Section II explains how the enabling language for CBM proceedings in the AIA, § 18(a)(1)(B) is different than the enabling language for IPR and PGR proceedings in 35 U.S.C. §§ 311(a) and 321(a). Section III explains the relevant historical practice associated with *ex parte* reexamination and *inter partes* reexamination as the backdrop before which Congress enacted the AIA. Section IV explains why governmental entities should be entitled to bring at least IPRs and PGRs, but perhaps not CBMs.

I. THERE IS NO GLOBAL DEFINITION OF "PERSON" IN THE PATENT ACT OR THE AIA

A review of the use of the term "person" throughout Title 35 of the U.S. Code and the AIA reflects the inescapable conclusion that "person" cannot have a global definition in the Patent Act, but must be tied to the specific language of the relevant provision of the Patent Act. Thus, this Section analyzes the various instances in which the term "person" is used in the Patent Act to demonstrate that there is no single consistent use that will reflect

whether a government entity like the USPS should be considered a "person" for purpose of 35 U.S.C. § 311(a), 35 U.S.C. § 321(a) and AIA § 18(a)(1)(B).

A. Implications of Interpreting "Person" to Include the Government

Some provisions of the Patent Act would not make any sense if they are construed as requiring "person" to include a governmental entity.

For example, Sections 3(a)(1) (identifying who can be the "Director") and 6(a) (identifying who can be an "administrative patent judge") use the term "person" to specify an individual and not an entity (government or otherwise):

> The Director shall be a **person** who has a professional background and experience in patent or trademark law.

35 U.S.C. § 3(a)(1).

> The administrative patent judges shall be **persons** of competent legal knowledge and scientific ability who are appointed by the Secretary, in consultation with the Director.

35 U.S.C. § 6(a).

Of course, a "person" or "persons" in both of these sections could include an individual in a government office acting in an official capacity.

Other provisions, discussing inventors, likewise suggest that "person" or "persons" as used in the Patent Act in this context identify an individual who is an inventor and not to an entity (government or otherwise):

> When an invention is made by two or more **persons** jointly, they shall apply for patent jointly and each make the required oath [that specifies the individuals who conceive and reduce to practice the invention], except as otherwise provided in this title.

35 U.S.C. § 116(a).

> Whenever through error a **person** is named in an application for patent as the inventor, or through an error an inventor is not named in an application, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

35 U.S.C. § 116(c).

> Whenever through error a **person** is named in an issued patent as the inventor, or through error an inventor

> is not named in an issued patent, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

35 U.S.C. § 256(a).

In this context, a "person" seems to be the individual that conceived the invention, and not an entity (such as the applicant or assignee). Of course, since Federal agencies may apply for patents on inventions[7] made by individuals working for the agency, such "persons" could include a person in a government office.

Similarly, in Section 201(c), "contractor" is defined to include "any person," which is distinguished from, and therefore is identified to be different from, a "small business firm" or "nonprofit organization":

> The term "contractor" means any **person**, small business firm, or nonprofit organization that is a party to a funding agreement.

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[7] *Cf.* 35 U.S.C. § 207(a)(1) ("Each Federal agency is authorized to . . . apply for, obtain, and maintain patents or other forms of protection in the United States and in foreign countries on inventions in which the Federal Government owns a right, title, or interest . . . .").

35 U.S.C. § 201(c). Thus, in this context, a "person" seems to be an individual, and not an entity (e.g., small business firm, or nonprofit organization). Hence, here, "person" also is distinct from, and does not appear to include, a government entity.

Further, Section 211 discusses "person" in a manner that would be inconsistent with including a government entity:

> Nothing in this chapter shall be deemed to convey to any **person** immunity from civil or criminal liability, or to create any defenses to actions, under any antitrust law.

35 U.S.C. § 211. This section suggests that "person" would not need to include government entities, since such entities would not need immunity from civil or criminal liability. However, "person" could include an individual working for the government, who may need such immunity.

Thus, in each of these instances, "person" is used in the Patent Act in a manner that would be inconsistent with defining it to include a government entity but could in at least some instances include an individual employed by the government, acting in his or her official capacity.

B. Implications of Interpreting "Person" to Exclude the Government

Other provisions of the Patent Act would lead to bizarre results if "person" were universally construed to exclude government entities.

For example, Section 207(a)(1) provides that a Federal agency can apply for, obtain, maintain and own patents (*see* note 7 *supra*). Accordingly, it would make no sense for purposes of Section 102, which defines what is prior art and what can be excluded from prior art, to adopt a construction of "person" to exclude the government. Section 102, in part, reads as follows:

> (a) A **person** shall be entitled to a patent unless—
>
> (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or
>
> (2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was

> effectively filed before the effective filing date of the claimed invention.
>
> (b)(2)(C) A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if . . . the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same **person** or subject to an obligation of assignment to the same **person**.

35 U.S.C. §§ 102(a) and 102(b)(2)(C).

If the scope of "person" in Section 102 excludes government entities, that means either such government entities are not entitled to patents under Section 102(a), which is inconsistent with 35 U.S.C. § 207(a)(1), or the government's patents are not invalid under the conditions of Section 102(a). Further, under such a construction, government patents would not be entitled to the exclusion set forth in Section 102(b)(2)(C). Neither of these interpretations can be correct.

Not only would excluding government entities from the meaning of "person" throughout the Patent Act lead to bizarre results with respect to prior art, but it would also lead to strange results with respect to Section 207(a)(1), as applied to other provisions of the Patent Act:

> A **person** to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A **person** who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties. If the Director grants a patent on an application filed under this section by a **person** other than the inventor, the patent shall be granted to the real party in interest and upon such notice to the inventor as the Director considers to be sufficient.

35 U.S.C. § 118.

> An application for patent for an invention filed in this country by any **person** who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same

> application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within 12 months from the earliest date on which such foreign application was filed.

35 U.S.C. § 119(a).

> Notwithstanding any other provisions of law any **person**, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that **person**, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such **person**, his successors, assigns, or legal representatives shall be invalid, unless the failure to procure such license was through error, and the patent does not disclose subject matter within the scope of section 181.

35 U.S.C. § 185.

If the scope of "person" excludes the government, the governmental entities do not need foreign filing license to file applications abroad.

In addition to 35 U.S.C. § 207(a)(1) authorizing Federal agencies to apply for patents, 37 C.F.R. § 1.46 makes clear that "person" includes assignees, which would include government entities.[8]

Construing "person" in Sections 252 and 318 regarding reissued patents as excluding government entities would likewise lead to the strange result of denying the government intervening rights:

> A reissued patent shall not abridge or affect the right of any **person** or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale,

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[8] *See* 37 C.F.R. § 1.46(a) ("A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent.").

> used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent.

35 U.S.C. § 252.

> Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes review under this chapter shall have the same effect as that specified in section 252 for reissued patents on the right of any **person** who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, before the issuance of a certificate under subsection (b).

35 U.S.C. § 318(c); *see also* 35 U.S.C. § 328(c).

Further, if "person" were to universally exclude government entities, then it would mean that such entities would not be entitled to cite prior art to the Office or institute *ex parte* reexaminations:

> Any **person** at any time may cite to the Office in writing—
>
> (1) prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent; or
>
> (2) statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent.

35 U.S.C. § 301 (2012 ed.).

> Any **person** at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301.

35 U.S.C. § 302. Such a position would be inconsistent with current PTO practice as set forth in MPEP § 2203 (citing prior art) and MPEP § 2212 (*ex parte* reexamination) and contrary to the historical practice as discussed in Section III *infra*.[9]

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[9] *See* MPEP § 2203 (9th ed. Rev. 08.2017, Jan. 2018) ("35 U.S.C. 301 states that 'Any person at any time may cite to the Office. . . .' **'Any person' may be** a corporate or

Finally, in at least one instance, Congress explicitly noted that "person" includes "government entities":

> Any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State, acting in his official capacity, shall not be immune, under the eleventh amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any **person, including any governmental or nongovernmental entity**, for infringement of a patent under section 271, or for any other violation under this title.

35 U.S.C. § 296(a).

In view of the foregoing, it is clear that in some provisions of the Patent Act, the term "person" necessarily should be interpreted to include the

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governmental entity as well as an individual."); MPEP § 2212 (9th ed. Rev. 08.2017, Jan. 2018) ("35 U.S.C. 302 and 37 CFR 1.510(a) both indicate that 'any person' may file a request for reexamination of a patent. Accordingly, there are no persons who are excluded from being able to seek reexamination. Corporations and/or **governmental entities are included within the scope of the term 'any person'**.").

government (*e.g.*, 35 U.S.C. § 296(a), expressly including government in the definition of "person"), while in other provisions the term "person" should be interpreted to exclude the government (*see, e.g.*, 35 U.S.C. §§ 3(a) and 6(a), which clearly exclude the governmental entities like the USPS, but would include individuals in the government's employ).

Accordingly, reliance on universal definitions from the Dictionary Act, 1 U.S.C. §§ 1 and 8, governing the U.S. Code in general, and likewise on other general definitions of "persons" from relevant case law (e.g., *Cooper*), may well cause inadvertent problems with respect to the Patent Act. Rather, as set forth below, the answer to the question posed by this case should depend on the legislative context relating to creation of various post-issuance patent challenge proceedings and the PTO's longstanding interpretation of "person" to include the governmental entities for purposes of *ex parte* and *inter partes* reexaminations. *Cf. Cooper*, 312 U.S. at 604-05 ("[T]here is no hard and fast rule of exclusion. The purpose, the subject matter, the context, the legislative history, and the executive interpretation of the statute are aids to construction which may indicate an intent, by the use of the term, to bring state or nation within the scope of the law.").

II. SECTION 18 OF THE AIA DEFINES THOSE WHO MAY BRING A CBM PROCEEDING DIFFERENTLY FROM THOSE WHO MAY BRING IPR AND PGR PROCEEDINGS UNDER 35 U.S.C. 311(a) AND 321(a)

Section 311(a) (for IPRs) and 321(a) (for PGRs) of Title 35 of the U.S.C. track each other very closely, and appear to use the term "person" in the same sense:

35 U.S.C. § 311(a) (for IPRs)	**35 U.S.C. § 321(a) (for PGRs)**
"Subject to the provisions of this chapter, a **person** who is not the owner of a patent may file with the Office a petition to institute **an inter partes review** of the patent."	"Subject to the provisions of this chapter, a **person** who is not the owner of a patent may file with the Office a petition to institute **a post-grant review** of the patent."

For CBMs, significantly different language was used in the AIA that may or may not use the term "person" in the same sense:

> A **person** may not file a petition for a transitional proceeding with respect to a covered business method patent unless the person or the person's real party in interest or privy has been **sued for infringement** of the patent or

> has been **charged** with infringement under that patent.

AIA § 18(a)(1)(B).

Because Congress elected to adopt different language and requirements for which "person" may file a petition for a CBM and which "person" may file a petition for an IPR or a PGR, the NYIPLA respectfully submits that the language and context of the statutory sections at issue should be carefully considered when deciding whether a "person" includes governmental entities for the purposes of CBM under Section 18(a)(1)(B) of the AIA. It is likely that this determination must be made independently of the meaning of "person" in 35 U.S.C. §§ 311(a) and 321(a).

III. HISTORICAL PRACTICE ALLOWED U.S. GOVERNMENT TO FILE REQUESTS FOR *EX PARTE* REEXAMINATIONS AND *INTER PARTES* REEXAMINATIONS

In analyzing the CBM, IPR and PGR requirements, the NYIPLA believes that the historical context of who was allowed to request the predecessor *ex parte* reexamination and *inter partes* reexamination is an important contextual factor underlying the proper interpretation of the AIA. In this regard, as this Court in *Oil States* recently explained:

Over the last several decades, Congress has created administrative processes that authorize the PTO to reconsider and cancel patent claims that were wrongly issued. **In 1980, Congress established "ex parte reexamination," which still exists today.** See Act To Amend the Patent and Trademark Laws, 35 U.S.C. §301 et seq. **Ex parte reexamination permits "[a]ny person at any time" to "file a request for reexamination."** §302. If the Director determines that there is "a substantial new question of patentability" for "any claim of the patent," the PTO can reexamine the patent. §§303(a), 304. The reexamination process follows the same procedures as the initial examination. §305.

In 1999, Congress added a procedure called "inter partes reexamination." See American Inventors Protection Act, §§4601-4608, 113 Stat. 1501A-567 to 1501A-572. **Under this procedure, any person could file a request for reexamination.** 35 U. S. C. §311(a) (2006 ed.). The Director would determine if the request raised "a substantial new question of patentability affecting any claim of the patent" and, if so, commence a reexamination. §§312(a), 313 (2006 ed.).

> The reexamination would follow the general procedures for initial examination, but would allow the third-party requester and the patent owner to participate in a limited manner by filing responses and replies. §§314(a), (b) (2006 ed.). Inter partes reexamination was phased out when the America Invents Act went into effect in 2012. See §6, 125 Stat. 299-305. . . .
>
> **The America Invents Act replaced inter partes reexamination with inter partes review**, the procedure at issue here. See id., at 299. **Any person other than the patent owner can file a petition for inter partes review**. 35 U. S. C. §311(a) (2012 ed.).

Oil States, 138 S. Ct. at 1370-71.

As background to the AIA, the PTO had long recognized that "person" for purposes of *ex parte* reexamination and the prior *inter partes* reexamination includes governmental entities, like USPS.

A. *Ex Parte* Reexamination

Under 35 U.S.C. § 302, "**[a]ny person at any time may file a request for [ex parte] reexamination** by the Office of any claim of a patent **on the basis of**

any prior art cited under the provisions of section 301."

Before revision by the AIA, Section 301 provided that:

> **Any person** at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent.

35 U.S.C. § 301 (2006 ed.).

The Patent Office's rules on *ex parte* reexamination and prior art citation simply parroted the statutory language:

> **Any person** may, at any time during the period of enforceability of a patent, file a request for an ex parte reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501

37 C.F.R. § 1.510(a) (2007).

However, in the revised version of the MPEP that was issued after *ex parte* reexamination was created, the PTO expressly interpreted "any person" who can file a request for *ex parte* reexamination under 35 U.S.C. § 302 and 37 C.F.R. § 1.510(a) to include "governmental entities":

> 35 U.S.C. 302 and 37 CFR 1.510(a) both indicate that "any person" may file a request for reexamination of a patent. Accordingly, there are no persons who are excluded from being able to seek reexamination. Corporations and/or **governmental entities are included within the scope of the term "any person"**.

MPEP § 2212 (4th ed. Rev. 7, July 1981). To date, the PTO has maintained this interpretation of "any person" under 35 U.S.C. § 302. *See* MPEP § 2212 (Rev. 08.2017, Jan. 2018).

In fact, prior to petitioning for CBM in the case below, the USPS requested *ex parte* reexamination of Return Mail's patent (Case No. 90/008,470). The PTO granted the USPS's request for *ex parte* reexamination and ultimately issued an *ex parte* reexamination certificate canceling all of the original claims and confirming the patentability of the new claims added by Return Mail during the reexamination. *See Ex Parte* Reexamination Certificate, U.S. Patent No. 6,826,548 C1. In other words, all of the claims challenged by the USPS in the CBM proceeding were obtained from the *ex parte* reexamination that the USPS was allowed to request.

B. *Inter Partes* Reexamination

Under 35 U.S.C. § 311(a) prior to enactment of the AIA, "**[a]ny third party requester at any time may file a request for inter partes reexamination** by the Office of a patent **on the basis of any prior art cited under the provisions of section 301**." 35 U.S.C. § 311(a) (2006 ed.).

The Patent Act explicitly defined "third party requester":

> The term "third-party requester" means a **person requesting** ex parte reexamination under section 302 or **inter partes reexamination under section 311 who is not the patent owner**.

35 U.S.C. § 100(e) (2006 ed.).

Similarly, before revision by the AIA, Section 301 provided that:

> **Any person** at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent.

35 U.S.C. § 301 (2006 ed.).

The PTO's rules on *inter partes* reexamination under Section 311 and prior art citation under Section 301 reflected the statutory language:

> Except as provided for in § 1.907, **any person other than the patent owner or its privies may**, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, **file a request for inter partes reexamination** by the Office of any claim of the patent **on the basis of prior art patents or printed publications cited under § 1.501**.

37 C.F.R. § 1.913 (2003).

> At any time during the period of enforceability of a patent, **any person** may cite, to the Office in writing, prior art consisting of patents or printed publications which the person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of the patent.

37 C.F.R. § 1.501(a) (2000).

Although the MPEP did not mention that the scope of the term "any third party requester" included governmental entities, the statutory

provisions and PTO rules on both *ex parte* reexamination and *inter partes* reexamination relied on the same term "person" to designate eligible reexamination requesters and also relied on 35 U.S.C. § 301 and 37 C.F.R. § 1.501 for the basis of reexamination.

In the MPEP, the Patent Office interpreted "any person" under 35 U.S.C. § 301 as including governmental entities:

> 35 U.S.C. 301 states that "Any person at any time may cite to the Office. . . . " **"Any person" may be** a corporate or **governmental entity** as well as an individual.

MPEP § 2203 (8th ed. Rev. 2, May 2004). To date, the PTO has maintained this interpretation of "any person" under 35 U.S.C. § 301. *See* MPEP § 2203 (9th ed. Rev. 08.2017, Jan. 2018).

On at least one occasion, the U.S. Government was allowed to request *inter partes* reexamination of a patent, which was subject of the pending litigation in the U.S. Court of Federal Claims. *See* Reexamination Request in *United States v. McGrath*, Case No. 95/001,970. The PTO granted the government's request for inter partes reexamination and, after the *inter partes* reexamination, subsequent appeal before the PTAB and dismissal of appeal by the Federal Circuit based on settlement, the PTO issued an *inter partes* reexamination

certificate canceling all of the original claims of the patent. *See Inter Partes* Reexamination Certificate U.S. Patent No. 7,296,503 C1.

IV. "PERSONS" FOR IPR AND PGR PROCEEDINGS MAY INCLUDE GOVERNMENTAL ENTITIES BASED ON HISTORICAL PRACTICE, WHILE "PERSONS" WHO CAN BRING CBM PROCEEDINGS MAY NOT

In view of the statutory right of the government to own patents and the PTO's longstanding interpretation of "person" as including governmental entities for purposes of reexaminations, and in the absence of legislative record indicating clear legislative intent to the contrary, the NYIPLA respectfully submits that the term "person," read contextually for the narrow purpose of identifying who can petition to institute an IPR and PGR, should include a "governmental entity" who is not the patent owner.

On the other hand, a "person" entitled to bring a CBM proceeding is based upon different criteria under AIA § 18(a)(1)(B) (*e.g.*, that "the person or the person's real party in interest or privy has been sued for infringement of the patent or has been charged with infringement under that patent"). These other features may inform the type of "person" who may bring a CBM proceeding without informing the type

of "person" who may bring an IPR or a PGR proceeding. [10]

CONCLUSION

As discussed herein, the legislative context relating to creation of post-issuance patent review proceedings and the PTO's longstanding interpretation of "person" to include the governmental entities for purposes of *ex parte* and *inter partes* reexaminations together support the interpretation that the government is a "person" who

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[10]The NYIPLA observes that the Court's refusal to take up Petitioner's second question leaves open the question of whether a taking under 28 U.S.C. § 1498 places the government under a "charge of infringement," which may still need to be considered as part of this proceeding. On the one hand, to the extent that a "takings" claim is not a "charge of infringement," this result may preclude a government entity from being a proper petitioner in a CBM proceeding even if this Court were to determine that a "person" can include a government entity. On the other hand, since the statue allows for privies to the "person" (such as, in the case of a government entity, a government contractor or supplier) to be the subject of such a charge, the distinction between a takings claim under Section 1498 and a charge of infringement may not be dispositive. Thus, while this does not bear directly, or end the inquiry, on the question of whether a government entity is a "person" having standing for purposes of filing CBM proceedings, the "privy" language of section 1498 arguably precludes resolution of the matter in reliance upon Section 1498.

may petition to institute IPR and PGRs proceedings under the Patent Act. However, the context of CBM proceedings is not the same and may lead to a different conclusion.

Thus, in view of the foregoing, the NYIPLA respectfully submits that the Court carefully consider the potential implications of interpreting "person" in Title 35 of the U.S. Code and the AIA as including or excluding the government generally, and then issue only a narrow holding on the scope of "person," under AIA § 18(a)(1)(B) and, if at all, under 35 U.S.C. §§ 311(a) and 321(a).

Respectfully submitted,

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